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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,134	08/06/2001	Atle Hedloy	103176-0001C1	9141
24267	7590	10/18/2006	EXAMINER	
CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210			LUU, SY D	
			ART UNIT	PAPER NUMBER
			2174	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,134

Applicant(s)

HEDLOY, ATLE

Examiner

Sy D. Luu

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-69 is/are allowed.
- 6) ☒ Claim(s) 70-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the RCE and Amendment filed 8/4/2006.
2. Claims 1-108 are pending in this application. In the instant Amendment, claims 1-34 were cancelled, and claims 35-108 were added. Claims 35, 53, 59, 65, 70, 77, 84, 91, 97, and 103 are independent claims. This action is made Non-Final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

4. Claims 70, 77 and 84 are objected to because of the following informalities. Paragraphs 2-4 of each of these claims are not properly constructed relative to the sentence structure. Specifically, for each of these claims, the “.” (period) at the end of paragraph 3 should be put at the end of paragraph 4 to mark the end of the sentence, and the word “and” after the end of paragraph 2 should be put at the end of paragraph 3.
5. Claims 73, 80 and 87 are objected to because of the following informalities: the phrase “inserting the second information in to the document” on lines 1-2 or line 2 is grammatically awkward. The Examiner believes that the phrase should be changed to ---inserting the second information into the document---.
6. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. Claims 70-75, 77-82, 84-89, 91-92, 94-98, 100-104, and 106-108 are rejected under 35 U.S.C. 102(b) as being anticipated by Tso (U.S. patent 6,085,201).

As per claims 70 and 73, Tso teach a method for information handling within a document operated on by a first application (*e.g. e-mail application 20, at figure 2*), the document containing first information entered by a user (col. 4, lines 32- 35), the method comprising the steps of:

identifying without user intervention the first information that can be utilized in a second application program (col. 4, lines 48-60; *template engine analyzes and determines without user intervention the portion of the message from the information passed by the first application program*);

responding to a user selection by inserting a second information into the document by adding the second information to the first information, the second information associated with the first information from a second application program, and responding to a user selection by inserting into the document a second information retrieved from a second application program through use of said first information (col. 6, line 66 – col. 7, line 2; *template engine 5*).

As to claim 71, Tso teaches the user selection to comprise an activation of a device selected from a group consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice command device (col. 3, lines 34-35; col. 4, lines 35-43).

As per claim 72, Tso further teaches the steps of: initializing the second application (col. 4, lines 48-51); searching, using the second application, for the second information associated

Art Unit: 2174

with the first information (col. 5, lines 7-17); and retrieving the second information (col. 5, lines 42-48).

As per claims 74-75, Tso teaches displaying the second information (col. 5, lines 42-44), and completing at least one of the search and second information (col. 6, lines 6-10).

Claims 77 and 80 are similar in scope to claims 70 and 73 respectively, and are therefore rejected under similar rationale.

Claims 78-79 and 81-82 are similar in scope to claims 71-72 and 74-75 respectively, and are therefore rejected under similar rationale.

Claims 84 and 87 are similar in scope to claims 70 and 73 respectively, and are therefore rejected under similar rationale.

Claims 85-86 and 88-89 are similar in scope to claims 71-72 and 74-75 respectively, and are therefore rejected under similar rationale.

Claims 91-92 are similar in scope to claims 70 and 74 respectively, and are therefore rejected under similar rationale.

As per claims 94-96, Tso teaches entering additional data associated with the search information into the second application program (col. 7, line 19) which is entered by a user (col. 7, lines 14-25), and located within a document (fig. 4; col. 6, lines 6-10).

Claims 97-98 are similar in scope to claims 91-92 respectively, and are therefore rejected under similar rationale.

Claims 100-102 are similar in scope to claims 94-96 respectively, and are therefore rejected under similar rationale.

Art Unit: 2174

Claims 103-104 are similar in scope to claims 91-92 respectively, and are therefore rejected under similar rationale.

Claims 106-108 are similar in scope to claims 94-96 respectively, and are therefore rejected under similar rationale.

Claim Rejections - 35 USC § 103

8. Claims 76, 83, 90, 93, 99 and 105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso (U.S. patent 6,085,201) in view of Pandit (U.S. patent 5,859,636).

As per claim 76, Tso does not expressly indicate the search information to comprise a name. However, it is known in the art that names are common information being used in an application such as email. For instance, Pandit teaches a method of recognition of text in a body of text and performing an operation relevant to the recognized text (col. 1, lines 51-53), wherein text such as names, email addresses are also recognized. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include Pandit's teaching with the invention of Tso because it allows for "transforming the text into an interface to other functions or operations".

Claims 83 and 90 are individually similar in scope to claim 76, and are therefore rejected under similar rationale.

Claim 93 is similar in scope to claim 76, and is therefore rejected under similar rationale. Pandit further teaches operations comprising creation of one or more of an e-mail, a telex, a fax, or a letter (col. 2, lines 39-41, 58-59; col. 2, line 67 – col. 3, line 8).

Art Unit: 2174

Claims 99 and 105 are individually similar in scope to claim 93, and are therefore rejected under similar rationale.

Allowable Subject Matter

9. Claims 35-69 are allowed.

10. Claims 35-69 are allowable over the art of record because the art of record does not disclose the recited limitations.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is (571) 272-4064. The examiner can normally be reached on Monday - Friday from 7:300 am to 4:00 pm (EST).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (571) 272-4063.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 2174

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SY D. LUU
PRIMARY EXAMINER
ART UNIT 2174